

### **ARGUMENTS/REMARKS**

In response to the Office Action dated September 9, 2005, Applicants respectfully request that the Office enter the amendments set forth above and consider the following remarks. By this response, Applicants amend claims 1, 5-7, 9-11, 13 and 16-17, cancel claims 8 and 15 without prejudice or disclaimer, and add new claims 18-23. After entry of this paper, claims 1-7, 9-14 and 16-23 will be pending in this application.

In the Office Action, the Examiner: (i) rejected claims 5-7 and 9 under 35 U.S.C. § 112, second paragraph, as indefinite; (ii) rejected claims 1-4 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,573,242 to Yoo ("Yoo"); (iii) rejected claims 5-7, 11 and 12 under 35 U.S.C. § 103(a) as allegedly unpatentable over Yoo in view of the knowledge of one skilled in the art; and (iv) provisionally rejected claims 1-17 as allegedly unpatentable on grounds of double-patenting in light of claims 1-27 of copending Application No. 10/812,067.

#### **35 U.S.C. § 112, ¶ 2, Rejections**

Claims 5-7 and 9 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner indicted that the phrases "preferably" or "preferable" are objectionable.

Applicants have amended claims 5-7 and 9 to remove the identified phrases. Accordingly, Applicants respectfully submit that the instant rejections have been overcome.

#### **35 U.S.C. § 102(b) Rejections**

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Yoo.

Without acquiescing to the rejection and in the interest of expediting prosecution, Applicant has amended independent claim 1 to clarify the claimed invention in view of the cited art and further obviate the rejection. Specifically, claim 1 has been amended to recite a racket with a frame profile having depressions, "wherein each pair of opposite depressions has an opening extending essentially perpendicular with respect to the

stringing plane of the racket through the frame profile.” No new matter has been added via this amendment. Applicants respectfully assert that Yoo does not teach or suggest the features recited in amended claim 1.

For example, the recited depressions and features of the depressions, such as that each depression “has an opening extending essentially perpendicular with respect to the stringing plane of the racket through the frame profile,” are not found in Yoo. Instead, Yoo discloses only thicker 21 and thinner 22 portions (see, e.g., Fig. 3, and col. 3, lines 23-43), with no teaching of an opening extending through the frame profile whatsoever. Therefore, Yoo cannot anticipate claim 1 due to its failure to teach or suggest openings associated with each depression, “extending essentially perpendicular with respect to the stringing plane of the racket through the frame profile.” For at least the above reasons, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §102(b) be withdrawn and the claim allowed. Additionally, claims 2-4, which directly or indirectly depend from claim 1, are also allowable for at least the same reasons.

#### 35 U.S.C. § 103(a) Rejections

Claims 5-7, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Yoo in view of the knowledge of one skilled in the art.

Claims 5-7, 11 and 12 directly or indirectly depend from amended claim 1, and are allowable over Yoo for at least the same reasons set forth above. Further, the additional assertions concerning the knowledge of one skilled in the art fail to cure this deficiency. Accordingly, Applicants respectfully request that the rejection of claims 5-7, 11 and 12 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

#### Double Patenting

Claims 1-17 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-27 of co-pending Application No. 10/812,067. Because neither set of claims has been granted, Applicants respectfully request that this issue be deferred until at least one set of claims is issued/allowed. If and when appropriate, Applicants propose to address this issue in the later-issuing application as it may develop. Additionally, Applicants also respectfully

note disagreement with the instant provisional rejection. For example, Applicants respectfully submit that the presently-claimed invention recites features (e.g., trough-shaped depressions and related limitations, etc.) differing in scope to the degree that neither set of amended claims renders the others unpatentable. Accordingly, for at least the above reasons, Applicants submit that instant provisional double-patenting rejection is overcome.

New Claims:

New claims 18-23 have been added to cover subject matter deleted from originally-presented claims 5-7 and 9, as set forth in the claim amendment section above. Accordingly, no new matter is added via these new claims. Additionally, new claims 18-23 ultimately depend from claim 1 and are thus allowable over the cited art for at least the same reasons. Applicants therefore respectfully request timely allowance of new claims 18-23.

Conclusion:

Finally, Applicants submit herewith an Information Disclosure Statement listing references for consideration by the Office.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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